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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/499,069	02/04/2000	Ted Eugene Wright	77017.002	9708

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EXAMINER

CARTER, MONICA SMITH

ART UNIT

PAPER NUMBER

3722

DATE MAILED: 08/27/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/499,069

Applicant(s)

WRIGHT, TED EUGENE

Examiner

Monica S. Carter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 August 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 11-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 11-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Preliminary amendment received August 05, 2002, has been entered.

Continued Prosecution Application

1. The request filed on August 05, 2002, for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/499,069 is acceptable and a CPA has been established. An action on the CPA follows.

Declaration

2. The declaration under 37 CFR 1.132 filed August 05, 2002, is insufficient to overcome the rejection of claims 1-7 and 11-15 based upon Skelton ('611), Cowan ('396), Jacobs et al. ('737) and Zoland ('956) applied under 35 U.S.C. 103 as set forth in the last Office action because: It refer(s) only to the system described in the above referenced application and not to the individual claims of the application. Thus, there is no showing that the objective evidence of nonobviousness is commensurate in scope with the claims. See MPEP § 716.

3. In view of the foregoing, when all of the evidence is considered, the totality of the rebuttal evidence of nonobviousness fails to outweigh the evidence of obviousness.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Skelton ('611) in view of Cowan ('396) and further in view of Jacobs et al. ('737).

Skelton discloses a single sheet form (23) (advertising medium for use in promoting hotels, restaurants, and the like (col. 1, lines 6-14)) comprising an unfolded form including a number of lines of perforations (44, 46, 48, 50, 52, 54, 56, and 58); the form including pre-printed textual and graphical information (col. 4, lines 53-65); the form being rectangular and having a greater vertical dimension than a horizontal dimension (col. 4, lines 28-35); and a lower tab (43) being separated from a central portion of the form by a horizontal line of perforations (45); wherein a packet is formed by folding the packet about the horizontal line of perforations and then about the vertical line of perforations.

Regarding the form being a key packet, in particular, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it

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meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In this case, the form of Skelton is capable of performing the intended use of being a key packet, as claimed.

Regarding the packet including at most two lines of perforations that allow the unfolded packet to be quickly and accurately folded into a complete packet in two or fewer steps, Skelton discloses that the total preferable number of panels is nine, however, "other total numbers of panels from three to eight may be utilized." (col. 4, lines 65-67). Therefore, if three panels were to be used, there would be only two lines of perforations for folding the form into a complete packet. The operation would require only two steps of folding (for example, folding the left panel over the middle panel and then folding the right panel over the middle panel) for completing the packet.

Skelton discloses the claimed invention except for a registration form placed at the top portion of the form and separated from the form by a line of perforations.

Cowan discloses a form (12) having a tab portion (form) (22) extending from the top of the form (12) and separated from the form (12) by a line of perforations (54). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the packet of Skelton to include a detachable form at the top

Point out
folding of
flap

is the
horizontal

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of the packet, as taught by Cowan, to provide an additional detachable flap for surrendering to someone for registration, ticketing, couponing, etc.

Regarding the form being a registration form, in particular, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In this case, the form (tab portion) of Skelton, as modified by Cowan, is capable of performing the intended use of being a registration form, as claimed.

Skelton, as modified by Cowan, discloses the claimed invention except for one or more die-cut slots in the unfolded packet for retaining a number of keys.

Jacobs et al. discloses a combined key holder and booklet having a die-cut slit (40) which is capable of retaining a hotel key. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the packet of Skelton to include a die-cut slit, as taught by Jacobs et al., to provide a retention means for items to be placed in the packet.

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6. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Skelton in view of Cowan and Jacobs et al. and further in view of Zoland ('956).

Skelton, as modified by Cowan and Jacobs et al., discloses the claimed invention except for the key being selected from a group consisting of metal and magnetic key cards.

Zoland discloses a thin leaf suitable for use as a card or key carrying case for holding hotel keys wherein the keys may be an ordinary metallic key or a flat card key with a magnetic stripe or other mechanism for encoding a key (col. 5, lines 9-22). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the packet of Skelton to include a magnetic key card for insertion into the pocket of the packet, as taught by Zoland, to provide an insert into the packet that may be used to obtain entry into a secure room and/or area.

7. Claims 11-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Skelton, in view of Cowan and Jacobs et al., as used above, and further in view of Pacione (6,299,401).

Skelton, as modified by Cowan and Jacobs et al., discloses that each of the panels may be printed with advertisement materials (i.e. redemption coupons, self addressed postage prepaid cards, printed display symbols, etc. – see col. 4, lines 53-56).

Skelton, as modified by Cowan and Jacobs et al., disclose the claimed invention except for explicitly disclosing that the advertisement materials are printed on the panels by feeding the panels through a commercially available computer printer.

Pacione discloses a blank or sheet (12) having two panels separated by perforated fold line (22). One of the panels (18) includes a tab portion (24) extending therefrom. The blank is fed through a desktop printer (70) to print indicia on the first surface (14) of the blank. Pacione further discloses that both surfaces (14 and 16) may include printing (see col. 5, lines 11-16). The tab portion can also receive printed indicia (123ABC) on both the inner (26) and outer (28) portions of the tab. The printer also has the capability of printing in color on the blank. The printer may be any conventional printer (i.e. impact printer, ink jet printer or laser printer) (see col. 4, lines 58-67 through col. 5, lines 1-28).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Skelton's invention to include feeding the sheet through a computer printer, as taught by Pacione, to provide printed advertisement, graphics, company logos, etc. on the sheet for the purpose of advertising a particular company and/or product.

Regarding claim 12, the sheet is made of paper.

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Regarding claim 13, the sheet is preprinted with textual and graphical information (see figures 14 and 15 and col. 4, lines 53-56).

Regarding claims 14 and 15, see the above rejections to claim 11.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica S. Carter whose telephone number is (703) 305-0305. The examiner can normally be reached on Monday-Thursday (8:00 AM - 5:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrea L. Wellington can be reached on (703) 308-2159. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.



Monica S. Carter
Examiner
Art Unit 3722
August 22, 2002